



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. 10/790,027 Confirmation No. 9737
Applicant John A. Giordano *et al.*
Filed 2 March 2004
TC/Art Unit 1616
Examiner F.I. Choi
Docket No. 48508-00014
Customer No. 23767

PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181(a)(1)

MAIL STOP PETITIONS

Director of the United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

11/18/2005 JADDO1 00000106 501067 10790027
01 FC:1462 400.00 DA

Sir:

The Applicants in the present application respectfully petition the Director of the United States Patent and Trademark Office to lift the suspension of *ex parte* prosecution imposed by the examiner in the application and to allow the application to issue. The prosecution of this application was suspended due to “a potential interference.” Office action of November 3, 2005, page 2. Applicants assert that this “potential interference” is not a good and sufficient cause to grant a suspension of prosecution under the circumstances, is inappropriate, and such a suspension would inflict undue hardship on the Applicants; thus, the examiner’s suspension should be lifted.

Petition may be taken to the Director from any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court. 37 C.F.R. § 1.181(a)(1). There are a host of various kinds of decisions that an examiner makes in the examination proceeding – mostly matters of a discretionary, procedural or nonsubstantive nature – which are not appealable to the Board of Patent Appeals or the court when they are not directly connected with the merits of issues involving rejection of claims, but traditionally have been settled by petition to the Commissioner. *In re Hengehold*, 440 F.2d 1395, 1403 (C.C.P.A. 1971). Among the actions not appealable to the Patent Office Board of Appeals unless directly connected with the

merits of issues involving the rejections of the claims are suspensions of action. *Ex parte Haas*, 1972 WL 17791, 175 U.S.P.Q. 217, 220 (B.P.A. 1972).

In a final office action mailed September 16, 2005 in the present application, all prior art rejections of the claims in the above-referenced application were withdrawn, leaving only two obviousness-type double patenting rejections at issue. On October 4, 2005, Applicants filed a response submitting a terminal disclaimer. In the office action mailed November 3, 2005, the terminal disclaimer was accepted and recorded, and the claims were deemed allowable. However, rather than issuing a Notice of Allowance, the examiner instead suspended *ex parte* prosecution for a period of six months due to a “potential interference.” Office action mailed November 3, 2005, page 2.

While the identity of the interfering application was not stated in the office action, Applicants believe the application is Nidamarty et al. (US 2003/0206969, effective filing date May 2, 2002), which was cited against the Applicants’ claims during prosecution. The claims of the present application were alleged to be anticipated under 35 U.S.C. § 102(e) and obvious under 35 U.S.C. § 103(a) due to Nidamarty et al.. Office action mailed August 11, 2004, page 3. In the response filed February 11, 2005, Applicants filed a Rule 131 affidavit with associated evidence that established that the claimed invention was reduced to practice prior to May 2, 2002. The Applicants’ Rule 131 affidavit has been accepted and entered. Office action mailed September 16, 2005. Nidamarty et al. is therefore no longer prior art to the above-referenced application.

It is inappropriate to suspend action on the above-referenced application due to a “potential interference” until the Nidamarty application issues. Interferences will not be declared between pending applications if there is a difference of more than 3 months in the effective filing dates of the oldest and the next oldest applications, in the case of inventions of a simple character, or a difference of more than 6 months in the effective filing dates of the applications in other cases, except in exceptional situations, as determined and approved by the TC Director. MPEP § 2303. As the effective filing dates of the two applications are May 2, 2002 (Nidamarty et al.) and December 10, 2002 (Giordano et al.), more than 6 months apart, an interference should not be declared between these pending applications. Therefore, to declare an interference between these two applications, one of them must first issue.

To delay this issuance of the above-referenced application until the Nidamarty application issues or is abandoned would inflict an unnecessary hardship upon the

Applicants. A final rejection was issued in the Nidamarty application on October 19, 2005, which maintained a rejection of the allegedly interfering claim and other claims under 35 U.S.C. § 103(a), and as well as other claims under 35 U.S.C. § 102(e). It therefore appears that the Nidamarty application is not close to issuance. To suspend action in the above-referenced application until the Nidamarty application issues is an unnecessary hardship on the Applicants when the same purpose would be served by allowing the present application to issue now.

Previously, a petition to withdraw a suspension of prosecution and allow an application involved in an interference to issue was denied, but under significantly different circumstances than the present. *Lin v. Fritsch*, 1989 WL 274430, 14 U.S.P.Q.2d 1795, 1802 (Com'r Pat. & Trademarks). "Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided." 37 C.F.R. § 1.181(f). Lin's petition to withdraw the examiner's six-month suspension order came almost five months after the action, and therefore was deemed untimely. *Lin*, 14 U.S.P.Q.2d at 1799. In contrast, the instant petition is filed well within the two-month period.

Furthermore, in *Lin* an interference had already been declared between the two patent applications when the petition was filed, and there was plausible evidence to show that Fritsch had invented the invention at issue before Lin's effective filing date. *Lin*, 14 U.S.P.Q.2d at 1800. This is in contrast to the instant case where no interference has been filed and may never be filed, and a Rule 131 affidavit has been accepted that shows the Applicants' reduction to practice prior to the filing date of Nidamarty.

Finally, in *Lin* the examiner could properly declare an interference between the applications without allowing one application to issue. *Lin*, 14 U.S.P.Q.2d at 1800. In contrast, in the present situation, one application must issue in order for there to be possibility of properly declaring an interference. The impediments to granting Lin's petition are therefore not present in the present application and its rationale is inapplicable.

Applicants therefore respectfully request that the Director withdraw the suspension of prosecution of the present application and allow it to issue. If there are any additional fees due in connection with the filing of this petition, please charge the fees to undersigned's Deposit Account No. 50-1067. If any extensions or fees are not accounted for, such extension is requested and the associated fee should be charged to our deposit account.

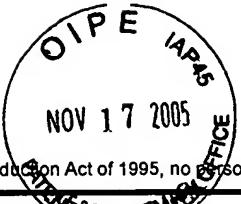
Respectfully submitted,

17 November 2005



Don J. Pelto
Reg. No. 33,754

Preston Gates Ellis & Rouvelas Meeds, L.L.P.
1735 New York Avenue NW, Suite 500
Washington, DC 20006
Telephone: (202) 628-1700
Facsimile: (202) 331-1024



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PTO/SB/17p (11-04)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

TFW

PETITIONER
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL

(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/790,027
Filing Date	2 March 2004
First Named Inventor	John A. Giordano
Art Unit	1616
Examiner Name	F.I. Choi
Attorney Docket Number	48508-00014

Enclosed is a petition filed under 37 CFR 1.181(a) (that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 400.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. *For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.*

Payment of Fees (small entity amounts are NOT available for the petition fees)

- The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 50-1067:
 petition fee under 37 CFR 1.17(f), (g) or (h) any deficiency of fees and credit of any overpayments
 Enclose a duplicative copy of this form for fee processing.
- Check in the amount of \$ _____ is enclosed.
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Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.53(e) - to accord a filing date.
- § 1.57(a) - to accord a filing date.
- § 1.182 - for decision on a question not specifically provided for.
- § 1.183 - to suspend the rules.
- § 1.378(e) - for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) - to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 - for access to an assignment record.
- § 1.14 - for access to an application.
- § 1.47 - for filing by other than all the inventors or a person not the inventor.
- § 1.59 - for expungement of information.
- § 1.103(a) - to suspend action in an application.
- § 1.136(b) - for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 - for review of refusal to publish a statutory invention registration.
- § 1.296 - to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 - for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) - for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 - for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 - for expedited handling of a foreign filing license.
- § 5.15 - for changing the scope of a license.
- § 5.25 - for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) - to request documents in a form other than that provided in this part.
- § 1.84 - for accepting color drawings or photographs.
- § 1.91 - for entry of a model or exhibit.
- § 1.102(d) - to make an application special.
- § 1.138(c) - to expressly abandon an application to avoid publication.
- § 1.313 - to withdraw an application from issue.
- § 1.314 - to defer issuance of a patent.

Signature

Don J. Pelto

Typed or printed name

17 November 2005

Date

33,754

Registration No., if applicable

This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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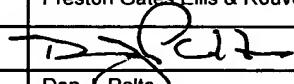
TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number 10/790,027 Filing Date 2 March 2004 First Named Inventor John A. Giordano Art Unit 1616 Examiner Name F.I. Choi
Total Number of Pages In this Submission		Attorney Docket Number 48508-00014

ENCLOSURES (check all that apply)			
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 27 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communications to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):	
<u>Remarks</u>			

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm Name	Preston Gates Ellis & Rouvelas Meeds, LLP		
Signature			
Printed Name	Don J. Pelto		
Date	17 November 2005	Reg. No.	33,754

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioners for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

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Type or Printed Name		Date	

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